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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/691,544	10/24/2003	Carl M. Burnett	51566.00002	6894
32294	7590	03/29/2006	EXAMINER	
SQUIRE, SANDERS & DEMPSEY L.L.P.			CHOULES, JACK M	
14TH FLOOR			ART UNIT	
8000 TOWERS CRESCENT			PAPER NUMBER	
TYSONS CORNER, VA 22182			2167	

DATE MAILED: 03/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/691,544

Applicant(s)

BURNETT, CARL M.

Examiner

Jack M. Choules

Art Unit

2167

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 8, 12, 14 and 17-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 8, 12, 14 and 17-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/13/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-4, 8, 12, 14, and 17-26 are presented for examination. This action is responsive to the amendment and arguments filed 24 February 2006.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-4, 8, 12, 14, and 17-26 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The invention as claimed in claims 1-4, 8, 12, 14, and 17-26 and interpreted in light of the specification particularly page 20 lines 5-14, is directed to a apparatus which is a combination of hardware and software or a method which is preformed using hardware and software or software per say, both apparatus and method performing a mathematical algorithm, formula, or calculation, and as such the claimed invention is subject to the test of State Street, 149 F.3d at 1373-74, 47 USPQ2d at 1601-02. Specifically State Street sets forth that the claimed invention must produce a ***“useful, concrete and tangible result.”*** The Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility states in section IV C. 2 b. (2) (on page 21 in the PDF format):

The tangible requirement does not necessarily mean that a claim must either be tied to a particular machine or apparatus or must operate to change

articles or materials to a different state or thing. However, the tangible requirement does require that the claim must recite more than a § 101 judicial exception, in that the process claim must set forth a practical application of that § 101 judicial exception to produce a real-world result. Benson, 409 U.S. at 71-72, 175 USPQ at 676-77 (invention ineligible because had “no substantial practical application.”).

Claims 1-4, 8, 12, 14, and 17-26 have the result of producing a single discrete all-natural number geospatial coordinate measurement representation, however the claims do not specify that the result (the single discrete all-natural number geospatial coordinate measurement representation) is displayed to a user or otherwise used in the real world. Although some claims such as 2, 3, 8, 14, 24, and 26 specify that the single discrete all-natural number geospatial coordinate measurement representation be encoded “onto a data segment of the video frame” no use of this data segment is set forth that would constitute a real-world result. Thus the claimed result is not tangible and thus the claimed result is not a “useful, concrete and tangible result.” The court in State Street noted that the claimed invention in Alappat constituted a practical application of an abstract idea because it produced *a useful, concrete and tangible result* the display of a smoothed heart beat to a system user. The Federal Circuit further ruled that it is of little relevance whether a claim is directed to a machine or process for the purpose of a § 101 analysis. AT&T, 172 F.3d at 1358, 50 USPQ2d at 1451 (see the Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility, Annex II).

The examiner reviewed the specification but was unable to find a practical real-world use of the result (the single discrete all-natural number geospatial coordinate measurement representation). If the applicant is able to find one and inserts it into the claims provide the location the element is found in the specification.

Claim Objections

Claims 1-4, 8, 12, 14, and 17-26 are objected under Title 37 C.F.R. 1.75 (d)(1) to because of the following informalities: Multiple terms used in the claims are not found in the specification. Specifically the examiner is unable to find the terms single, discrete, all-natural number, or the phrase “single discrete all-natural number geospatial coordinate measurement representation.”

Appropriate correction is required.

Title 37 C.F.R. 1.75 (d)(1):

The claim or claims must conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description. (See § 1.58(a)).

Since figure 26 shows the concatenation that forms this result it is suggested that a more complete description of figure 26 be included in the specification to actually describe the figure with language corresponding to the language in the claims. It is noted that a disruption of a figure is not new mater as long as describes only that which is shown in the figure.

Response to Arguments

Applicant's arguments filed 13 February 2006 have been fully considered and found to be persuasive as directed to the rejection under 35 U.S.C. § 102 and 35 U.S.C. § 103 and those rejections have been withdrawn. The rejections under 35 U.S.C. § 112 first and second paragraph have been withdrawn as the amendments have corrected the deficiencies the rejections were directed to.

Applicant's arguments filed 13 February 2006 in relation to the rejections under 35 U.S.C. 101 have been fully considered but they are not persuasive.

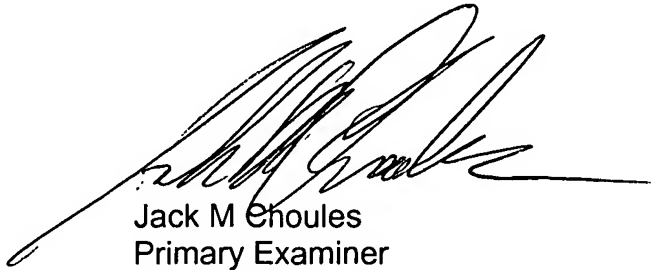
The applicant argues that the amendments place the claims within the scope of patentable subject matter under 35 U.S.C. 101. The examiner respectfully disagrees. Claims 1-4, 8, 12, 14, and 17-26 have the result of producing a single discrete all-natural number geospatial coordinate measurement representation, however the claims do not specify that the result (the single discrete all-natural number geospatial coordinate measurement representation) is displayed to a user or otherwise used in the real world. Although some claims such as 2, 3, 8, 14, 24, and 26 specify that the single discrete all-natural number geospatial coordinate measurement representation be encoded "onto a data segment of the video frame" no use of this data segment is set forth that would constitute a real-world result. Thus the claimed result is not tangible and thus the claimed result is not a useful, concrete and tangible result and thus not patentable subject matter under 35 O.K. 101.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jack M. Choules whose telephone number is (571) 272-4109. The examiner can normally be reached on M-F (7:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene can be reached on (571) 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jack M Choules
Primary Examiner
Art Unit 2167

25 November 2005